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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,722	08/27/2001	Ronald A. Schachar	PRES06-00217	5803

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Docket Clerk  
P.O. Drawer 800889  
Dallas, TX 75380

EXAMINER

WILLSE, DAVID H

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 11/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/940,722

Applicant(s)

SCHACHAR, RONALD A.

Examiner

Dave Wills

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 61-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 61-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on August 27, 2001, is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

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The Applicant has failed to specifically point out the support in the original disclosure for each of the newly presented claims and claim limitations (M.P.E.P. 714.02), and must correct the deficiency in response to the instant Office action.

The disclosure is objected to because of the following informalities: The continuation data inserted on page 1 of the specification is inaccurate in that U.S. Application Serial No. 09/061,168 is a continuation-in-part (rather than a continuation) of U.S. Application Serial No. 08/946,975; also, the respective patent numbers should be inserted as appropriate. On page 13, line 3, "zonules 115" are not indicated in the drawings. On page 17, line 2, "11" should apparently be --10--; on line 22, "412" should be --416--; on line 24, "410" should be --414--. On page 19, lines 7 and 14, the same reference numeral is used to denote two different features; on line 12, "614" should be --616--. On page 28, lines 13 and 15, "2" and "3" should apparently be interchanged. **Other errors were noted.** Appropriate correction is required.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the generally semicircular and elliptical prostheses (e.g., claim 64) must be shown or the features canceled from the claim. No new matter should be entered.

Claims 61-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 61, line 4, "scleral" should be replaced by --sclera--. In claim 63, line 1, "an" should be replaced by --and--. In claim 65, line 3, "said base" lacks a proper antecedent basis. In claim 74, the scleral pocket appears to be a positively recited feature in the claim body, which is thus inconsistent with the preamble, drawn only to the prosthesis; it is recommended

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that on line 4, "applying" be replaced by --configured to apply-- or the like. *Other errors were noted.*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 74-79 are rejected under 35 U.S.C. 101 for reasons explained in the last paragraph of M.P.E.P. 2105. However, this rejection may be overcome with the revision recommended above.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees (*In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969)).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application (37 CFR 1.130(b)).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 61-79 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,280,468 B1.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant features are either found in or would have been immediately obvious from the claim limitations of the patent. For example, the expanding means would have been obvious from patent claims 1, 56, and 57.

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Claims 61-79 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,007,578 or 6,299,640 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present limitations are found among the claimed elements of each patent.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.


Claims 61-68, 70, and 74-79 are rejected under 35 U.S.C. 102(b) as being anticipated by Schachar, US 5,354,331. An elongated body and an expanding means as set forth in instant claim 61 are evident from column 7, lines 1-12, and the drawings. It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform; it does not constitute a limitation in any patentable sense (*In re Hutchison*, 69 USPQ 138); at least one of the faces and both of the edge surfaces of the patented Schachar band are deemed to be *capable* of contacting the sclera. Regarding claim 62, the expanding means may be viewed as the ridge (or thread) of the screw mechanism described at column 7, lines 8-12.

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Claims 69 and 71-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schachar, US 5,354,331. Regarding claim 69, the particular dimensions for each of the "plurality of parts" (column 7, line 2) would have been obvious from anatomical considerations. Regarding claims 71-73, an internal cavity filled with saline solution or the like would have been obvious from the requirements described at column 6, lines 40-45, and from the diversity of other materials acceptable to Schachar (column 6, lines 45-64).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is (703) 308-2903 and who is generally available Monday through Thursday during most of each day. The supervisor, Corrine McDermott, can be reached at (703) 308-2111. The receptionist's phone number is (703) 308-0858, and the main FAX numbers are (703) 305-3591, 3590.

dhw: D. Willse  
November 25, 2002

  
**DAVE WILLSE**  
**PRIMARY EXAMINER**  
**ART UNIT 3738**